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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/494,374	01/31/2000	Cesar Compadre	23533/119	3327

22428 7590 02/26/2003

FOLEY AND LARDNER  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER
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WARE, TODD

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 02/26/2003

24

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/494,374

Applicant(s)

COMPADRE ET AL.

Examiner

Todd D Ware

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 52-107 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 52-107 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Receipt of request for extension of time (granted), notice of appeal both filed 7-30-02 and amendment filed 11-13-02 is acknowledged. Claims 31-35 and 37-39 have been canceled and new claims 52-107.

### ***Continued Prosecution Application***

1. The request filed on 9-30-02 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/494,374 is acceptable and a CPA has been established. An action on the CPA follows.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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3. Claims 52, 82-84, 86-87, 102-103, 107 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Smith et al (5,414,124; hereafter '124).

'124 discloses germicidal compositions comprising about 50-80% of a quaternary ammonium compound in 48-84% propylene glycol and water for the remainder (see abstract; C 1, L 13-17; C 3, L 23- C 4, L 44; examples; claims).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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**6. Claims 53-61, 65-81, 85, 90-101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al (5,414,124; hereafter '124) in view of Gauvreau et al (3,787,566; hereafter '566).**

'124 teaches germicidal compositions comprising about 50-80% of a quaternary ammonium compound in 48-84% propylene glycol and water for the remainder. '124 does not teach the limitations where the quaternary ammonium compound is an alkylpyridinium salt, a tetra-alkylammonium salt, or an alkylalicyclic ammonium salt (see abstract; C 1, L 13-17; C 3, L 23- C 4, L 44; examples; claims).

'566 is relied upon for teaching inclusion of cetyl pyridinium in disinfecting compositions (abstract; C 2, L 34-C 3, L 45; examples; claims).

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to either include cetyl pyridinium in the composition of '124 for an additive disinfecting effect or substitute cetyl pyridinium for the quaternary ammonium compounds of '124 based upon the availability of the quaternary ammonium compound and the expectation that these compounds are antimicrobial.

**7. Claims 62, 89, and 104-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al (5,414,124; hereafter '124) in view of The Merck Index (1983).**

'124 is relied upon for all that it teaches as stated previously. '124 does not teach glycerol as a solvent for quaternary ammonium compounds. See abstract; C 1, L 13-17; C 3, L 23- C 4, L 44; examples; claims.

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The Merck Index teaches that propylene glycol and glycerol are substitutes for each other (are equivalents). See pages 1130-1131.

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to combine propylene glycol and glycerol with the expectation of the solvents having an additive effect and the motivation of requiring less of each individual solvent in the formulation.

**8. Claim 88 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hall (5,405,604; hereafter '604) in view of Vidra (4,205,061; hereafter '061) and further in view of The Merck Index (1983).**

'604 teaches a concentrated mouth rinse comprising about 10% of a quaternary ammonium compound in a solvent comprising propylene glycol (abstract; C 4, L 45-C 5, L 9; examples; claims).

'061 is relied upon for teaching solvent formulations for quaternary ammonium compounds comprising glycerol and ethyl alcohol (abstract; example 3).

The Merck Index is relied upon for teaching that glycerol and propylene glycol are equivalents. See pages 1130-1131.

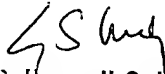
Accordingly, it would have been obvious to one skilled in the art at the time of the invention to combine ethanol in the formulation of '604 with the motivation of providing an additive dissolving effect and the motivation of requiring less of each individual solvent in the formulation.

**Conclusion**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd D Ware whose telephone number is (703) 305-1700. The examiner can normally be reached on M-F, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on (703)308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

  
Gollamudi S. Mishore, PhD  
Primary Examiner  
Group 1600

tw  
February 24, 2003